REMARKS

At the outset, the Examiner is thanked for the thorough review and consideration of the Office Action dated November 12, 2008 and has carefully reviewed its contents. In the Office Action, the only pending rejection is a provisional non-statutory double patenting rejection of claims 22-47 of the present application over claims 1-49 of co-owned and co-pending Patent Application No. 10/374,751 ("the '751 Application").

As outlined in the Manual of Patent Examining Procedure (M.P.E.P.), the analysis in an obviousness-type double patenting rejection parallels the factual inquiries set forth for determining obviousness under 35 U.S.C. § 103(a). M.P.E.P. 804, II, B. 1. (8th Ed., Rev. 5). A distinction, however, is that the focus of the inquiry in a non-statutory double patenting context is a comparison of the scope of the claims. *Id.* Among the factual inquiries to be made with respect to a non-statutory double patenting rejections are:

> (A) Determine the scope and content of a patent ***claim*** relative to a ***claim*** in the application at issue;
>
> (B) Determine the differences between the scope and content of the patent ***claim*** as determined in (A) and the ***claim*** in the application at issue; and
>
> (C) Determine the level of ordinary skill in the pertinent art.

In rejecting the claims, the Office Action states "although the claims are not patentably distinct from each other because all of the features of the instant claims are corresponding to the copending claims expect for the copending claims do not disclose expressly a first groove has a width less than about 1mm." Office Action, p. 2. Applicant submits that there are other differences in the claims that affect the scope of the claims, including a flooring system having at least two planks as claimed in the instant application.

The Office Action is correct in that the claims of the '751 Application do not recite "wherein said first groove has a width of less than 1mm." Moreover, the claims of the '751 Application were amended after the date of the instant office action, and thus also differ from the claims of the present application in that they recite, for example, "the first groove configured to provide a visual or textural effect that each of the at least two substantially coplanar sub-surfaces is a unitary plank." '751 Application, claim 22.

After addressing the differences between the scope and content of the claims of the '751 Application and the present application, it is necessary to determine the level of ordinary skill in the art. M.P.E.P. 804. Moreover, the M.P.E.P. instructs examiner's to make clear " The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue is anticipated by, or would have been an obvious variation of, the invention defined in a claim in the patent. *Id.* The Office Action states that the first groove having a width less than about 1mm "would have been a matter of obvious design choice to one of ordinary skill in the art at the time the invention was made to have such a smaller groove, e.g. less than 1mm for it cosmetically purposes [sic]. Furthermore, applicant has not disclosed the criticality of this feature." Office Action, pp. 2-3.

First, the Office Action does not address what the level of one of ordinary skill in the pertinent art, as per the factual inquires discussed above. Second, the reason given for the "obviousness" of the present claims is "obvious design choice to one of ordinary skill in the art at the time the invention was made to have such a smaller groove." However, the range of a size of the groove would not have been apparent, or within the skill of one of ordinary skill, without resorting to looking at the disclosure of the instant application. Third, the "criticality" of a feature has no bearing in a determination of obviousness-type double patenting. Applicant has

no obligation to show "criticality" of any feature to show that the claims of the instant application are patentably distinct over the '751 Application.

In view of the foregoing Remarks, Applicants believe the application is in condition for allowance and early, favorable action is respectfully solicited.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at (202) 496-7500 to discuss the steps necessary for placing the application in condition for allowance. All correspondence should continue to be sent to the below-listed address.

If these papers are not considered timely filed by the Patent and Trademark Office, then a petition is hereby made under 37 C.F.R. §1.136, and any additional fees required under 37 C.F.R. §1.136 for any necessary extension of time, or any other fees required to complete the filing of this response, may be charged to Deposit Account No. 50-0911. Please credit any overpayment to deposit Account No. 50-0911.

Respectfully submitted,

Dated: May 12, 2009

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